

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 18-20, 23, and 41-46 are pending. Claims 15-23 were originally filed. Claims 15-17 and 21-22 were previously canceled. Claims 18, 19, 20, and 23 were previously amended. Claims 40-47 were previously added. Claims 40 and 47 are currently canceled without prejudice.

All of the pending claims were rejected in the July 9th, 2003 Office Action.

The Claim Rejections Under 35 U.S.C. §102

Claims 18-20 and 42-44 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,552,967 to Seto et al. (hereinafter, "Seto").

Applicant respectfully submits that the subject matter recited in each of the claims discussed below is patentably distinct from Seto, as will become apparent.

Claim 18, previously amended, recites a portable handheld computing device comprising:

- a casing having upper and lower surfaces, opposing front and back side surfaces, and opposing end surfaces, the ends being dimensionally shorter than the front and back side surfaces; and
- a light emitting device mounted externally on the casing, the light emitting device being positioned on the upper surface and wrapping around to and being raised on one of the end surfaces, the light emitting device being activated upon occurrence of an event to notify a user.

In making out various claim rejections in the present Office Action, the Office argues that feature (254) shown in Figure 1 of Seto teaches a "light emitting device (LED) mounted externally on the casing, the LED being positioned on the

1 upper surface and wrapping around to and being raised on one of the end
2 surfaces". (Paragraph 6 of present Action). Applicant respectfully disagrees.

3 First, the cited indicator 254 of Seto is not positioned on an upper surface
4 and wrapping around an end surface. The cited indicator 254 is located at a
5 meeting point of a front wall 8a and a top wall 8b of a section 8. (See Seto, col.
6 23, lines 57-68, col. 10, lines 38-44, and Fig. 1). These walls, rather than
7 wrapping to an end surface, are integral with a top cover 6, as shown in Figs. 1, 7
8 and 8. (See also Seto at col. 23, lines 57-68 and col. 10, lines 41-44). In sum, the
9 cited indicator 254 simply does not wrap around to or even contact an end surface.

10 Secondly, the cited indicator 254 of Seto is not raised on an end surface.
11 Seto discloses the indicator 254 as flush with the front wall 8a and the top wall 8b
12 of section 8. (See Seto, Fig. 7).

13 Thus, the apparatus cited by the Office does not disclose a light emitting
14 device being positioned on the upper surface and *wrapping around to and being*
15 *raised on one of the end surfaces*, as claim 18 requires.

16 Claim 19, previously amended, recites a portable handheld computing
17 device comprising:

- 18
- 19 • a casing having a base and a lid; and
 - 20 • a light emitting device mounted externally and raised on the lid, the
21 light emitting device being activated upon occurrence of an event to
22 notify a user.

23 In making out various claim rejections in the present Office Action, the
24 Office argues that feature (254) of Figure 1 of Seto, along with features shown in
25

1 Figures 1 and 8 of Seto, anticipate claim 19. (Paragraph 6 of present Action).

2 Applicant respectfully disagrees.

3 Claim 19 recites a structure of "a light emitting device mounted externally
4 and raised on the lid". This structure is not disclosed by Seto.

5 First, the indicator 254 cited by the Office is in the cover 6, shown in
6 Figure 1 of Seto. But the cover 6 is not a lid. (See Seto, Figure 1). Seto teaches
7 "a display unit 3 ... hinged to the base unit 2", which is arguably a lid. (See Seto;
8 Figure 1 and col. 10, lines 18-20). The indicator 254 relied on by the Office,
9 however, is not in the display unit 3—it is in the cover 6. Thus, Seto fails to
10 disclose a light emitting device mounted on a lid.

11 Second, the indicator 254 cited by the Office is not "raised". As shown
12 above, Seto teaches that the indicator 254 is flush with its surrounding surfaces.
13 (See *supra*).

14 Thus, the apparatus cited by the Office does not disclose a light emitting
15 device *mounted externally and raised on the lid*, as required by claim 19.

16 Claim 20, previously amended, recites a portable handheld computing
17 device comprising:

- 18
- 19 • a casing having a base and a lid that opens and closes relative to the
20 base, the lid having an upper surface, opposing side surfaces, and
21 opposing end surfaces; and
 - 22 • a light emitting device mounted externally on the casing, the light
23 emitting device being activated upon occurrence of an event to
24 notify a user, positioned on the upper surface of the lid, and
25 wrapping around to one of the end surfaces so that the light emitting
device is visible from both opposing side surfaces and both opposing
end surfaces when the lid is opened or closed.

1 In making out various claim rejections in the present Office Action, the
2 Office argues that Figures 1 and 8 (presumably with the feature (254)) of Seto
3 discloses an LED "positioned on the upper surface [sic] of the lid, and wrapping
4 around to one of the end surfaces so that the LED is visible from both opposing
5 side surfaces and both opposing end surfaces when the lid is opened or closed."
6 (Paragraph 6 of present Action). Applicant respectfully disagrees.

7 First, and as stated above, Seto fails to disclose an LED positioned on a lid.
8 (*See Supra*).

9 Second, also as stated above, Seto fails to disclose an LED wrapping
10 around to an end surface. (*See Supra*).

11 Third, Seto fails to disclose an LED that is "visible from both opposing side
12 surfaces and both opposing end surfaces when the lid is opened or closed." Seto,
13 rather, teaches that the indicator (254), as shown in Figure 8, is not visible from
14 any side surface or end surface when the display 3 is closed. (*See Seto*, Figure 8).

15 Thus, the apparatus cited by the Office does not disclose "a light emitting
16 device ... positioned on the upper surface of the lid, and wrapping around to one
17 of the end surfaces so that the light emitting device is visible from both opposing
18 side surfaces and both opposing end surfaces when the lid is opened or closed", as
19 required by claim 20.

20 Claim 42, previously added, recites a portable handheld computing device
21 comprising:

- 22
- 23 • a casing having upper and lower surfaces, front and back side
24 surfaces, and opposing end surfaces; and
 - 25 • a light emitting device mounted externally on the casing,
 - wherein the light emitting device is:
 - activated upon occurrence of an event to notify a user; and

- positioned such that the light emitting device is visible from the upper surface, one of the side surfaces, and one of the end surfaces.

Claim 42 recites a light emitting device positioned such that "the light emitting device is visible from the upper surface, one of the side surfaces, and one of the end surfaces".

The claimed light emitting device performs differently than the indicator (254) disclosed by Seto. As is clear from Figures 1 and 8, Seto does not disclose a light emitting device that performs the function of being "visible from ... one of the side surfaces, and one of the end surfaces". (See Seto, Figures 1 and 8). The indicator (254) of Seto, rather, teaches an LED visible, when the display unit 3 is open, by a viewer looking in a direction perpendicular to a side wall 5b that is furthest from the open display unit 3. (See Seto, col. 10, lines 28-37 and Figure 1). Seto simply does not disclose that the indicator (254) is visible from any of the other three side walls 5b. (*Id.*). Further, when the display unit 3 is closed, the indicator (254) is not visible when viewed from a direction perpendicular to any of the side walls 5b. (*Id.*). Thus, the claimed light emitting device performs differently than the apparatus disclosed in Seto.

Dependent claims 43-44, previously added, depend from claim 42 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in claim 42, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

The Claim Rejections Under 35 U.S.C. §103(a)

Claims 23, 41, and 45-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Seto in view of U.S. Patent No. 6,041,215 to Maddrell et al. (hereinafter, "Maddrell"), U.S. Patent No. 4,056,701 to Weber (hereinafter, "Weber"), U.S. Patent No. 4,454,596 to Wunsch et al. (hereinafter, "Wunsch"), or U.S. Patent No. 5,606,712 to Hidaka (hereinafter, "Hidaka").

The Office admits differences between what Seto discloses and what the claims recite, stating that these differences are "Design Choice" matters. In support of this rejection, the Office takes official notice on design choice matters for off-button integration and light-emitting device and button combinations, as well as the physical situations of the LED. The Office writes that Maddrell, Weber, Wunsch, and Hidaka demonstrate these design choices.

Dependent claim 23, previously amended, depends from claim 18 and is allowable as depending from an allowable base claim. This claim is also allowable for its own recited features that, in combination with those recited in claim 18, are neither disclosed nor suggested in references of record, either singly or in combination with one another.

Further, the Office admits that Seto "does not expressly disclose ... off button integration". (Paragraph 8 of present Action). To address this deficiency, the Office states that "such difference in limitation is a design choice matter to one having ordinary skill in the art", taking "official notice on such design choice matter as off button integration." (*Id.*).

Rejection of claims as a "design choice" matter are appropriate when a change in an element's size or proportion "would not perform differently than the prior art device." (M.P.E.P. §2144.04(IV)(A), citing *Gardner v. TEC Systems*,

1 *Inc.* 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830,
2 225 USPQ 232 (1984)).

3 Design-choice rejections are not appropriate, however, when a claimed
4 structure and the function it performs are different from the prior art. *See In re*
5 *Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) (finding of "obvious design
6 choice" precluded where the claimed structure and the function it performs are
7 different from the prior art).

8 As in two prior Responses, mailed June 16th, 2003 and January 3, 2003,
9 Applicant respectfully objects to and traverses the taking of official notice. In
10 accordance with M.P.E.P. §2144.03, Applicant again requests that the Office
11 produce art teaching a "button being integrated with the light emitting device" in
12 relation to a light emitting device being activated upon occurrence of an event to
13 notify a user. The Office refers to Weber, Wunsch, Maddrell, and Hidaka, but
14 these references do not teach a button integrated with a light emitting device in
15 relation to being activated upon occurrence of an event to notify a user. Lacking
16 such a reference or due to its dependency on base claim 18, Applicant respectfully
17 requests the §103 rejection of claim 23 be withdrawn.

18 **Dependent claim 41**, previously added, is allowable at least by virtue of its
19 dependency on dependent claim 23 and base claim 18. This claim is also allowable
20 for its own recited features that, in combination with those recited in claims 18 and
21 23, are neither disclosed nor suggested in references of record, either singly or in
22 combination with one another.

23 **Dependent claims 45-46**, previously added, depend from claim 42 and are
24 allowable as depending from an allowable base claim. These claims are also
25 allowable for their own recited features that, in combination with those recited in

1 claim 42, are neither disclosed nor suggested in references of record, either singly
2 or in combination with one another.

3 Further, the Office admits that Seto "does not expressly disclose ... the
4 physical situations of the LED". (Paragraph 8 of present Action). To address this
5 deficiency, the Office states that "such difference in limitation is a design choice
6 matter to one having ordinary skill in the art", taking "official notice on such
7 design choice matter as off button integration." (*Id.*).

8 Applicant respectfully objects to and traverses the taking of official notice.
9 In accordance with M.P.E.P. §2144.03, Applicant requests that the Office produce
10 art teaching a light emitting device "further visible from the bottom surface" or
11 "further visible from the bottom surface, another end surface, and another side
12 surface" in relation to a light emitting device being activated upon occurrence of
13 an event to notify a user. The Office refers to Weber, Wunsch, Maddrell, and
14 Hidaka, but has not shown that these references teach a light emitting device
15 "positioned such that the light emitting device is visible from the upper surface,
16 one of the side surfaces, and one of the end surfaces" and "wherein the light
17 emitting device is further visible from the bottom surface" or "wherein the light
18 emitting device is further visible from the bottom surface, another end surface, and
19 another side surface."

CONCLUSION

All pending claims 18-20, 23, and 41-46 are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

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